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EXAMINER

PHAM, KHANH B

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/603,207

Filing Date: June 25, 2003

Appellant(s): KEMP, RICHARD DOUGLAS

Jon E. Gordon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/22/2011 appealing from the Office action mailed 1/21/2011.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-12, 16-24, 30, 32-35, 56-69 are pending and stand rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

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subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

2006/0253449

WILLIAMSON ET AL

11-2006

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-12, 16-24, 30, 32-35, 56-69** are rejected under 35 U.S.C. 102(e) as being anticipated by Williamson et al. (US 2006/0253449 A1), hereinafter "**Williamson**".

As per claim 1, Williamson teaches a system for providing legal information comprising:

- “at least one computer and a plurality of user terminals with communicate over a network” at Fig. 1;
- “at least one database associated with the at least one computer storing the legal information in association with a plurality of legal topics and a plurality of types of legal information” at Figs. 2-3
- “a computer readable medium or media storing programming that cause the at least one computer to access within the at least one database a plurality of items of legal information responsive to a request received from a user terminal” at [0033]-[0035];
- “each of legal information being associated with one or more respective topic tag identifying a legal topic or subtopic associated with the associated item of legal information” at [0014]-[0015], [0041]-[0046];
- “and each type tag identifying a type of legal information corresponding to the associated item of legal information” at [0041]-[0047];
- “cause each item of legal information associated with the accessed information to be provided for display on a display device associated with the user terminal from which the request was received” at Figs. 4-6;
- “automatically tabulated by the respective type tags and configured to be selectable at the user terminal to provide a request for display on the display device of the content associated with the selected item” at [0051]-[0054] and Figs. 4-6.

As per claim 2, Williamson teaches the system of claim 1 , wherein "the plurality of types of legal information comprises at least two of: administrative action, legislative action, rulemaking, reported judicial decisions and news" at Figs. 4-6.

As per claim 3, Williamson teaches the system of claim 1, wherein "causing each item of legal information to be display comprises causing each item of legal information to be provided for display in a separate display window by type" at Figs. 4-6.

As per claim 4, Williamson teaches the system of claim 3, wherein "the plurality of types of legal information comprises at least two of : "administrative action, legislative action, rulemaking, reported judicial decisions, court filings, news, and secondary materials" at Figs. 4-6.

As per claim 5, Williamson teaches the system of claim 3, wherein "the plurality of types of legal information comprises at least: administrative action, legislative action, rulemaking, reported judicial decisions, court filings, news, and secondary materials" at Figs. 4-6.

As per claim 6, Williamson teaches the system of claim 1, wherein "legal topics comprising at least two of: admiralty and maritime; alternative dispute resolution; antitrust; trade regulation; banking; finance; bankruptcy; business; commercial; consumer rights; corporate; business organizations; civil rights; collectibles and

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personal property; communications; media; constitutional; construction; contracts; criminal; education; employment; labor; entertainment; gaming; sports; environmental; estates, trusts, and wills; family; government; elections and politics; government benefits; government contracts; government administration; state government; local government; health; human rights; immigration; insurance; intellectual property; copyrights; patents; trademarks; international; international trade; internet; litigation; litigation administration; appellate procedure; civil procedure; damages and remedies; evidence; mergers and acquisitions; military; natural resources; energy; native populations; professions and occupations; professional licensing; professional responsibility; products liability; real property; science and technology; securities; US federal taxation; state taxation; international taxation; torts; transportation; and workers' rights" at Figs. 4-6.

As per claim 7, Williamson teaches the system of claim 1, wherein "the programming causes the at least one computer to:

- "automatically access within the at least one database new legal information responsive to the request while each item of legal information associated with the previously accessed legal information is provided for display on the display device" at [0036], [0070] and Fig. 9;
- "provide for display on the display device each item of legal information associated with the accessed new legal information together with each item of

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legal information associated with the previously accessed legal information all tabulated by type” at [0036], [0070] and Fig.9.

As per claim 8, Williamson teaches the system of claim 1, wherein “the programming causes the at least one computer to :

- “automatically and periodically access the at least one database to determine whether new legal information responsive to the request is stored within the at least one database while each item of legal information associated with the previously accessed legal information is provided for display on the display device” at [0036], [0070] and Fig. 9;
- “if new legal information responsive to the request is stored within the at least one database, provide for display on the display device each item of legal information associated with the new legal information together with each item of legal information associated with the previously accessed legal information all tabulated by type” at [0036], [0070] and Fig. 9.

As per claim 9, Williamson teaches the system of claim 1, wherein the programming causes the at least one computer to :

- “automatically and continually access the at least one database to determine whether new legal information responsive to the request is stored within the at least one database while each item of legal information associated with the

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previously accessed legal information is provided for display on the display device” at [0036], [0070] and Fig. 9;

- “if new legal information responsive to the request is stored within the at least one database, provide for display on the display device each item of legal information associated with the new legal information all tabulated by type” at [0036], [0070] and Fig. 9.

As per claim 10, Williamson teaches the system of claim 1, comprising “a plurality of databases for storing the legal information, wherein the legal information is stored in separate databases by legal topic” at [0042] and Fig. 3.

As per claim 11, Williamson teaches the system of claim 1, comprising “plurality of databases for storing the legal information, wherein the legal information is stored in separate databases by type of legal information” at [0042] and Fig. 3.

As per claim 12, Williamson teaches the system of claim 1, comprising “a plurality of databases for storing the legal information, wherein the legal information is provided by a plurality of sources, and the legal information is stored in separate databases according to the source that provided the information” at [0042] and Fig. 3.

As per claim 16, Williamson teaches the system of claim 1, wherein “the programming causes the at least one computer to display on the display device tabulated by type each item of legal information provided for display” at Figs. 4-6

As per claim 17, Williamson teaches the system of claim 16, wherein “each item of legal information displayed on the display device is associated with a selectable link to the associated content, and wherein the programming causes the at least one computer to generate a request to retrieve the associated content from the at least one database in response to selection of a selectable link at the user terminal” at Figs. 4-6.

As per claim 56, Williamson teaches the system of claim 16, wherein “the programming stored on the computer readable medium or media causes the at least one computer to provide for display on the display device content associated with a displayed item of legal information in response to selection thereof at the user terminal” at [0037].

As per claim 57, Williamson teaches the system of claim 56, wherein “the programming stored on the computer readable medium or media cause the at least one computer to display on the display device the content provided for display” at [0037].

As per claim 18, Williamson teaches the system of claim 57, wherein “the displayed content comprises a complete version of a document” at Figs. 4-6.

As per claim 19, Williamson teaches the system of claim 57, wherein “the displayed content comprises an abbreviated version of a document” at Figs. 4-6.

As per claim 20, Williamson teaches the system of claim 19, wherein “the abbreviated version of a document comprises a summary of a document” at Figs. 4-6.

As per claim 21, Williamson teaches the system of claim 19, wherein “the abbreviated version of a document comprises at least one redacted portion of a document” at Figs. 4-6.

As per claim 22, Williamson teaches the system of claim 16, wherein “the displayed content information comprises at least a partial image of a document” at Figs. 4-6.

As per claim 23, Williamson teaches the system of claim 57, wherein “displayed content and a displayed item of information with which the displayed content is associated are displayed in different display windows” at Figs. 4-6.

As per claim 24, Williamson teaches the system of claim 57, wherein “displayed content and displayed item of information with which the displayed content is associated are displayed in different monitor screens” at Figs. 4-6.

As per claims 30, 69, Williamson teaches a method of processing legal information comprising:

- “assigning to each of a plurality of documents which each comprises legal information relating to a plurality of legal topics at least one identifier associated with (a) at least one of the legal topics and (b) at least one of a plurality of types of legal information” at [0041]-[0046] and Figs. 2-3;
- “formatting the documents according to a protocol” at [0043];
- “storing the formatted documents in at least one database” at Figs. 2-3;
- “using identifiers associated with the stored documents to identify documents within the at least one database responsive to a request received from a user terminal for information related to at least one of the plurality of legal topics” at [0051]-[0054];
- “causing legal information associated with the identified documents to be provided for displayed on the display device, automatically tabulated by type according to the identifiers associated with the respective identified documents” at Figs. 4-6.

As per claim 32, Williamson teaches the method of claim 30, wherein “documents are stored in a plurality of databases” at Fig. 3.

As per claim 33, Williamson teaches the method of claim 32, wherein “the documents are stored in the plurality of databases according to at least one of: the topics in relation to which respective document are stored, the type assigned to the documents, and a source of the documents” at Fig. 3.

As per claim 34, Williamson teaches the method of claim 30, comprising:
“checking formatted documents for compliance with a document receiving protocol; and
generating a notice of defects automatically upon determination that a checked
document does not comply with the protocol” at [0039].

As per claim 35, Williamson teaches the method of claim 34, comprising
“automatically performing the assigning and formatting steps on the non-complying
document” at [0039].

As per claims 58, 68, Williamson teaches a method for providing legal information
comprising

- “associated items of legal information and content in a system comprising at least one computer and a plurality of user terminals which communicate over a network” at Fig. 1;
- “and at least one database associated with the at least one computer storing a plurality of items of legal information” at Figs. 1-3;
- “each item of legal information being associated with one or more respective topic tag and one or more respective type tags, each topic tag identifying a legal topic or subtopic associated with the associated item of legal information, and each type tag identifying a type of legal information corresponding to the associated item of legal information” at [0041]-[0046] and Figs. 2-3;

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- “the at least one computer accessing within the at least one database legal information responsive to a request from a user terminal” at Figs. 1-6;
- “the at least one computer providing for display on a display device associated with the user terminal from which the request was received each item of legal information associated with the accessed information” at [0051]-[0054] and Figs. 3-6
- “automatically tabulated by the respective type tag and configured to be selectable at the user terminal to provide a request for display on the display device of the content associated with the selected item” at Figs. 3-6.

As per claim 59, Williamson teaches the method of claim 58, comprising “the at least one computer displaying on the display device tabulate by type each item of legal information provided for display” at Figs. 4-6.

As per claim 60, Williamson teaches the method of claim 59, comprising “the at least one computer providing for display on the display device content associated with a displayed item of legal information in response to selection thereof at the user terminal” at Figs. 4-6.

As per claim 61, Williamson teaches the method of claim 60, comprising “the at least one computer displaying on the displayed device the content provided for display” at Figs. 4-6.

As per claim 62, Williamson teaches the method of claim 59, wherein “displaying each item of legal information comprises displaying each item of legal information in a separate display window by type” at Figs. 4-6.

As per claim 63, Williamson teaches the method of claim 61, wherein “displaying the content comprises displaying the content in a different display window than each associated displayed item” at Figs. 4-6.

As per claim 64, Williamson teaches the method of claim 61, wherein “displaying the content comprises displaying the content in a different monitor screen than each associated displayed item” at Figs. 4-6.

As per claim 65, Williamson teaches the method of claim 59, wherein “each item of legal information displayed on the display device is associated with a selectable link to associated content, the method comprising generating a request to retrieve the associated content by selection of a selectable link at the user terminal” at [0046].

As per claim 66, Williamson teaches the method of claim 58, comprising “the at least one computer: automatically accessing within the at least one database new legal information responsive to the request while providing for display each item of legal information associated with the previously accessed legal information; and providing for display on the display device each item of legal information associated with the

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accessed new legal information together with each item of legal information associated with the previously accessed legal information all tabulated by type" at [0070] and Fig. 9.

As per claim 67, Williamson teaches the method of claim 60, comprising the at least one computer: automatically and periodically accessing the at least one database to determine whether new legal information responsive to the request is stored within the at least one database while each item of legal information associated with the previously accessed legal information is provided for display on the display device; and if new legal information responsive to the request is stored within the at least one database, providing for display on the display device each item of legal information associated with the new legal information together with each item of legal information associated with the previously accessed legal information all tabulated by type" at [0036], [0070] and Fig. 9.

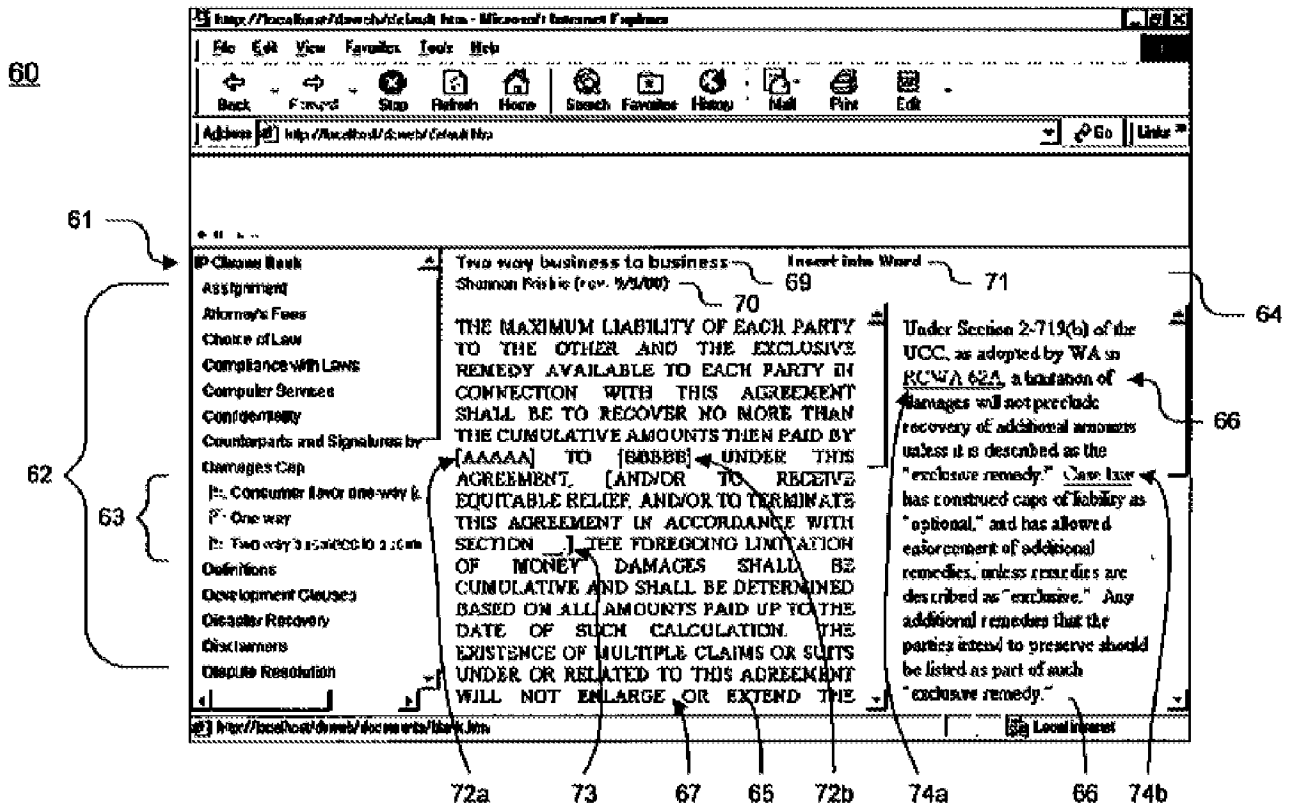
(10) Response to Argument

A. 102(e) rejection as being anticipated by Williamson et al.

1. Claims 1, 3, 5-6, 16-24, 56-61, 63-65, and 68.

Regarding claim 1, Appellant argued that "Williamson fails to teach or suggest **item of legal information**". Specifically, Appellant argued that "there are not items of

Fig. 4.



Appellant further argued that “nothing in Fig. 4 can be the items of legal information” and “display of items of only a single type logically cannot include tabulation of item by type. On the contrary, Williamson's Fig. 4 clearly shows a table includes plurality of legal information, which is used to draft legal document. Please also note the title of Williamson application: “System and method for efficiently drafting a **legal document** using an authenticated **clause table**”.

Appellant further argued “nothing in Williamson would correspond to the claimed topic and topic tags”. On the contrary, Williamson clearly teaches at [0054], in conjunction with Fig. 4 above, that “The clause selection module 60 exports

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a user interface with document drafting controls. The clause selection module 60 presents a **topic heading** 61 and a **topic listing**, divided into **general topics** 62 and **specific topics** 63 from which a user can select a particular clause". Williamson's Fig. 4 clearly show a plurality of topic tags (i.e. "general topics" 62, "specific topics" 63) for user's selection.

Appellant further argued that William's at paragraph [0033]-[0035] fails to teach or suggest "accessing within the at least one database a plurality of items of legal information responsive to a request received from a user terminal". On the contrary, William clearly teaches this limitation at [0033] :

"The local server 11 provides access to a shareable database...Each client 12 executes a browser 20 which provides a user interface into the Legal Document Drafting System 17..."

Appellant further argued that Williamson fails to teaches "causing the item of legal information to be displayed, automatically tabulated according to their type tags". Applicant's specification at [0009] provides: "Information is provided in tabulated form when it is sorted, placed in a tables, **or presented logically**". Williamson clearly teaches at Figs. 4-6 a table which displayed legal information, tabulated according the their type tags. For example, Fig. 4 show a clause selection module 60 displayed in a table, which allows user to select a clause to be displayed on the clause panel 65:

In view of the foregoing arguments, the 102 rejection of claims **1, 3, 5-6, 16-24, 56-61, 63-65, and 68** should be sustained.

2. Claims 2 and 4.

Regarding claims 2 and 4, Appellant argued that Williamson fails to teaches or suggest "wherein the plurality of types of legal information comprises at least two of: administrative action, legislative action, rulemaking, reported judicial decisions, and news" and "court filling" and "secondary material". However, as seen in Appellant's Fig. 4, above, the claimed "types of legal information" are just labels for different group of information. The claimed types of legal information are just well-known definition of "legal information", they are non-functional descriptive material, do not have any patentable weight and do not limit the claims.

When "non-functional descriptive material" is recorded or stored in a memory or other medium (i.e., substrate) it is treated as analogous to printed matter cases where what is printed on a substrate bears no functional relationship to the substrate and is given no patentable weight. See *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight."). See also *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1003, *aff'd* Rule 36 Jun. 12, 2006). **The Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate.** See *In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004).

Williamson teaches at Fig. 4 different types of legal information and therefore anticipated the claimed limitations.

3. Claims 7-9, 62, and 66-67.

Regarding claim 7, Appellant argued that Williamson does not teach “automatically access new legal information responsive to the request while each item of legal information associated with the previous access legal information is provided for displayed on the display device”. On the contrary, Williamson teaches at [0036] that “Annotation can be associated with the outlines, clauses and terms... the annotation can include hyperlinks to local and external reference source...”. Therefore, new legal information (i.e., “annotation”) can be requested by clicking on the hyperlink associated with the legal information displayed on the display device as claimed. Williamson’s Fig. 4 shows two hyperlinks 74a and 74b which allow user to request new annotation while the legal information is displayed.

4. Claims 30 and 34-35.

Regarding claim 30, Appellant argued that Williamson fails to teach or suggest “causing legal information associated with the identified documents to be provided for display on the display device, automatically tabulated by type according to the identifiers associated with the respective identified document”. On the contrary, Williamson clearly anticipated this limitation as discussed above, in view of Fig.4.

Appellant further argued that Williamson does not teach “formatting the document according to a protocol”. On the contrary, Williamson teaches at [0039] that the legal documents are formatted using tag-delimited language such as HTML or XML, and therefore anticipated the claimed limitation.

5. **Claims 10-12 and 32-33.**

Regarding claims 10-12, Appellant argued that Williamson fails to teach or suggest more than one database. On the contrary, Williamson teaches at [0042] that “the database 19 is relationally organized into a logical set of tables, lists, and indices which are related through table links. There are four logical tables: clause table 40, outline table 41, annotation 42 and learn topics 44.” Williamson therefore teaches a plurality of databases (i.e. “logical tables”) for separately storing different type of legal information (i.e. “clause”, “outline”, “annotation”).

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

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Respectfully submitted,

/Khanh B. Pham/

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/Hosain T Alam/

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